

Appl. No. 10/719,076
Reply to Office Action of 11/30/2005
Attorney Docket No.: 6045-006
Customer No.: 29,335

Remarks/Arguments:

In the Office Action dated November 30, 2005 the Examiner rejected claim 13 under 35 U.S.C. 112(b) second paragraph as being indefinite, rejected claims 9, 10, 12-14, and 16-18 under 35 U.S.C. 102(b) as being anticipated by Snedeker Patent 774,994, rejected claims 9, 10, 12, 13, and 16-18 under 35 U.S.C. 102(b) as being anticipated by the Rennie Patent No. 191,368 rejected claim 15 under 35 U.S.C. 103(a) as being unpatentable over Snedeker and over Rennie in view of Brownell Patent 6,234,549. No other basis of rejection was stated of record.

Background of the Law

The standard for indefiniteness has been set fairly high. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001). A claim is not indefinite merely because its scope is not ascertainable from the face of the claims; rather, it is indefinite if it is insolubly ambiguous. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1342, 65 USPQ2d 1385, 1406 (Fed. Cir. 2003). Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Allen Eng'g v. Bartell Indus.*, 299 F.3d 1336, 1350, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002), see e.g. MPEP §2173.02.

In order to establish a proper anticipation under 35 U.S.C. §102, each and every element of the claimed invention must be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The claimed elements must either be inherent or disclosed expressly in the single prior art reference, *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988), and must be arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). The absence from the reference of any claimed element necessarily negates anticipation. *Kloster Speedsteel AB. v. Crucible Inc.*, 793 F.2d 1565, 220 USPQ 81 (Fed. Cir. 1986).

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The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; and there is no litmus test defining when a preamble limits the scope of a claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim". *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).

Obviousness under 35 U.S.C. §103 is a question of law based on findings of underlying *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q (BNA) 459, 467, 15 L.Ed. 2d 545, 86 S.Ct. 684 (1966). To establish a prima facie case of obviousness, there must be some teaching, suggestion, or motivation in the prior art to make the specific combination or modification suggested by the Examiner. *In re Raynes*, 7 F.3d 1037, 1039, 28 USPPQ2d 1630, 1631 (Fed. Cir. 1993). Obviousness cannot be established by hindsight combination or modification to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991).

Summary of Amendments

Applicant has amended Claims 16, and 17 according to Examiner's suggestions to overcome Examiner's objections. Applicant has amended Claim 9 to more clearly state and define subject matter regarded as the invention. Applicant has withdrawn Claim 13, as Examiner had restricted this claim and Applicant had elected Claim 9, 10 and 12-18, which are readable on Figures 1-2. Applicant has withdrawn Claim 12 and 13. The amendments do not add new matter to the application. Applicant respectfully submits that the newly submitted Claims define patentable subject matter over the prior art of record in this application.

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The Snedeker Reference does not Anticipate a Terminating End Edge that Proximately Faces the Planar Base and Forms a Substantially Closed Cylinder Bounded at the First and Lateral Side Walls, or a Handheld Culinary Utensil with No Other Handle for Gripping

Applicant has amended Claim 9 to include limitations not anticipated by the Snedeker reference but properly supported by Applicant's disclosure. The Snedeker reference does not disclose an *arcuate handle comprising a terminating end edge being positioned proximate to the planar base and forming a substantially closed cylinder bounded at the first and second lateral side walls*. The Snedeker reference discloses a terminating edge that is *distant* from the planar base and which *facing away* from the planar base. And, the Snedeker dustpan discloses an arcuate handle 5a that forms a substantially *open cylinder* with dust-pocket 6. Moreover, the Snedeker reference does not disclose a substantially *closed* cylinder bounded by lateral side walls. Therefore, the Snedeker reference does not contain each and every limitation as to anticipate Claim 9.

Furthermore, the Snedeker reference does not contain the limitation that the utensil has "no other handle for gripping said utensil". The Snedeker reference discloses protruding handle 7, which is used for gripping the dustpan. Col 1, lines 22-25. And Applicant's limitation "no other handle for gripping said utensil" has proper basis in the original disclosure, where the Applicant describes a handleless food scoop as a "device that lacks a protruding handle used to grip the device". Pg. 2, ¶0010. Since the boundaries and limitations of Claim 9 are clearly set forth, the Snedeker reference does not disclose a device with no other handle for gripping as to anticipate Claim 9.

Additionally, the Snedeker reference does not disclose "handheld culinary utensil for holding food objects and limiting spillage". A handheld culinary utensil for holding food objects and limiting spillage is a limitation, which is necessary to give life, meaning, and vitality to the claim. The present invention is meant for efficiently transporting food objects with good maneuverability around a kitchen area by virtue of a lack of protruding parts, i.e. handheld culinary utensil. ¶0008. The Snedeker reference could not be used a handheld culinary utensil for holding food objects and limiting spillage due to the fact the Snedeker reference discloses a

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dust pan, which is also mounted on *protruding handle 7* as to cause the dust pan to automatically assume a position to receive dust when *placed upon the floor*. Col 1, lines 22-25. Therefore, the Snedeker dustpan is not handheld and not a utensil for holding food objects as to anticipate claim 9.

And finally, the Snedeker reference does not contain the limitation that the arcuate handle adapted to be held by a user's hand, because the arcuate flange 5a in the Snedeker reference contains bail 9. Bail 9 connects to handle 7 and pivots on the opposite sides of the pan, thereby preventing a user from gripping arcuate flange 5a. Col. 2, lines 94-96. Bail 9 provides no space available for a hand to hold arcuate flange 5a and it pivots around the pan to clamp down on a user's hand. Therefore, the Snedeker reference does not contain the limitation that the arcuate handle is adapted to be held by a user's hand.

With regard to Claim 14, Figure 4 of the Snedeker reference does not teach or show that the terminating edge of the arcuate handle is substantially *facing rearwardly*. Clearly from figure 4, the Snedeker dustpan has a terminating edge that is substantially facing *upwardly*, and Claim 14 has the limitation of the terminating edge of the arcuate handle substantially facing *rearwardly*. Since, figure 4 of the Snedeker reference does contain each and every limitation from Claim 14; the Snedeker reference does not anticipate Claim 14.

Accordingly, based upon the foregoing express disclosure and teaching of the Snedeker reference, express claimed elements of the presently pending claims are clearly not present in the reference, and consequently, inappropriate as a basis for anticipation under 35 U.S.C. §102(b).

The Rennie Reference Does not Anticipate a Terminating End Edge that Proximately Faces the Planar Base and Forms a Substantially Closed Cylinder Bounded at the First and Lateral Side Walls, or a Handheld Culinary Utensil with No Other Handle for Gripping

Applicant has amended Claim 9 to include limitations not anticipated by the Rennie reference. The Rennie dustpan does not disclose an *arcuate handle comprising a terminating end edge being positioned proximate to the planar base and forming a substantially closed cylinder bounded at the first and second lateral side walls*. The Rennie dustpan does not even

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disclose a terminating edge, but discloses opening *c*. Fig. 1 & 2. More so, opening *c* is not proximate to the planar base and does not form a substantially closed cylinder. Fig. 1 & 2. Therefore, the Rennie dustpan does not contain each and every limitation as to anticipate claim 9.

Moreover, the Rennie dustpan does not contain the limitation that the arcuate handle is a “rearwardly extending projection integral with planar base and curved *upwardly* from the planar base”. The Rennie dustpan discloses an arcuate handle that is curved *downwardly* from the planar base. Fig. 1 & 2. Also, the Rennie dustpan does not show a *terminating end edge of the generally forwardly curving section*. At best, the Rennie dustpan discloses opening *c* of the recess being substantially circular and continuous with lateral side-walls *e*. Fig. 1 & 2.

Additionally, the Rennie reference does not contain the limitation that the utensil has “no other handle for gripping said utensil”. The Rennie reference discloses handle D that protrudes from the disclosed dustpan. See Figure 2. And Applicant’s limitation “no other handle for gripping said utensil” has proper basis in the original disclosure, where the Applicant describes a handleless food scoop as a “device that lacks a protruding handle used to grip the device”. Pg. 2, ¶0010. Since the boundaries and limitations of Claim 9 are clearly set forth, the Rennie reference does not disclose a device with no other handle for gripping as to anticipate Claim 9.

And lastly, the Rennie reference does not disclose “handheld culinary utensil for holding food objects and limiting spillage”. A handheld culinary utensil for holding food objects and limiting spillage is a limitation, which is necessary to give life, meaning, and vitality to the claim. The present invention is meant for efficiently transporting food objects with good maneuverability around a kitchen area, by virtue of a lack of protruding parts, i.e. handheld culinary utensil. ¶0008. The Rennie reference could not be used a handheld culinary utensil for holding food objects and limiting spillage due to the fact the Rennie reference discloses a *dust pan with handle D* that protrudes from the disclosed dust pan. See Figure 2.

Accordingly, based upon the foregoing express disclosure and teaching of the Rennie reference, express claimed elements of the presently pending claims are clearly not present in the reference, and consequently, inappropriate as a basis for anticipation under 35 U.S.C. §102(b).

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The Snedeker Reference Does Not Render Claim 15 Obvious Because It Does Contain a Terminating End Edge that Proximately Faces the Planar Base and Forms a Substantially Closed Cylinder Bounded at the First and Lateral Side Walls, or a Handheld Culinary Utensil with No Other Handle for Gripping

As noted above, the Snedeker reference does not contain each and every limitation of Claim 9; therefore, the Snedeker reference cannot render Claim 15 obvious. Claim 15 is a dependent claim of Claim 9, so Claim 15 contains the limitation that the *arcuate handle comprising a terminating end edge being positioned proximate to the planar base and forming a substantially closed cylinder bounded at the first and second lateral side walls*. The Snedeker dustpan discloses a terminating edge that is *distant* from the planar base. And, the Snedeker dustpan discloses an arcuate handle 5a that forms an *open cylinder* with dust-pocket 6. Therefore, the Snedeker reference does not contain each and every limitation as to render Claim 15 obvious.

Accordingly, express claimed elements of the presently pending claim are not present in the Snedeker reference. Applicant submits that Claim 15 are patentably distinct over the Snedeker Reference and requests the Examiner's favorable reconsideration of the §103(a) obviousness rejection based upon the Snedeker reference.

The Rennie Reference in light of the Brownell Reference Does Not Render Claim 15 Obvious Because It Does Contain a Terminating End Edge that Proximately Faces the Planar Base and Forms a Substantially Closed Cylinder Bounded at the First and Lateral Side Walls, and Brownell is a Non-Analogous Art

As noted above, the Rennie reference does not contain each and every limitation of Claim 9; therefore, the Rennie reference cannot render Claim 15 obvious. Claim 15 is a dependent claim of Claim 9, so Claim 15 contains the limitation of the *arcuate handle comprising a terminating end edge being positioned proximate to the planar base and forming a substantially closed cylinder bounded at the first and second lateral side walls*. The Rennie dustpan does not

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even disclose a terminating edge, but discloses opening *c* that is not proximate to the planar base. Fig. 1 & 2. And, the Rennie dustpan discloses a considerable opening *c* that is not substantially closed. Fig. 1 & 2. Therefore, the Rennie dustpan does not contain each and every limitation as to render Claim 15 obvious.

Furthermore, the Brownell reference is a non-analogous art, because it is not within the applicant's field of endeavor or reasonably pertinent to the particular problem with which the applicant is concerned. Applicant's field of endeavor is manipulating and transporting food objects for the purposes of food preparation and cooking. ¶0003. While the Brownell's field of endeavor is hand held portable devices such as trowels as related to cat-litter scoopers employed in the process of sifting out the contaminated debris. Col 1, Lines 6-8.

Additionally, the present invention was preliminary classified in the U.S. Class 220, pertaining to receptacles, while the Brownell reference is classified in U.S. Class 294, pertaining to hand and hoist-line implements. Moreover, there are significant structural differences between the current application and Brownell, i.e. transverse transitional-bend portions 36/36' and contaminant bowl area 12/12'. Therefore, Applicant respectfully submits that the Brownell reference is in a non-analogous field of art, and therefore, inappropriate as a reference under 35 U.S.C. §103(a).

Accordingly, express claimed elements of the presently pending claim are not present in the Rennie reference and the Brownell reference is a non-analogous art; therefore Rennie in light of Brownell is inappropriate as a basis for obviousness under 35 U.S.C. 103(a).

Summary

Accordingly, Applicant submits that the pending claims are patentably distinct from and over the art cited and of record. Favorable reconsideration of the rejection of the pending claims is solicited.

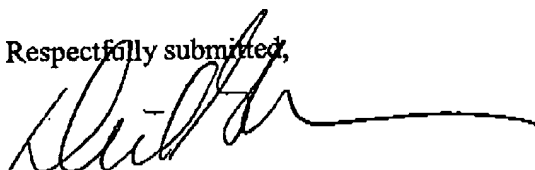
This Amendment Letter is being concurrently filed with a Request for Continued Examination and a Transmittal Letter that includes a claim fee calculation and any applicable requests for extension of time, which may be required for the proper presentation and

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consideration of the present amendments. While no additional fees other than those stated in the Transmittal Letter are believed to be required in connection with the filing of this amendment, the Director is hereby authorized to deduct any such fees from Deposit Account No. 18-2000 of which the undersigned is an authorized signatory.

Applicant solicits the Examiner's favorable reconsideration of the rejections and objections of record and submits that the presently pending claims are allowable over the art cited and of record, and therefore requests that Claims 9-18 be allowed. Should the Examiner find that there are any outstanding matters that are susceptible of resolution by telephone interview; the Examiner is invited to telephone the undersigned to discuss the same.

Respectfully submitted,



David G. Rosenbaum
Reg. No. 31,872

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Rosenbaum and Associates, P.C.
650 Dundee Road
Suite 380
Northbrook, IL 60062
Tel. 847-770-6000
Fax. 847-770-6006
Email: drosenbaum@biopatentlaw.com